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10/716,123	11/17/2003	Robin Kay Deverich	102US001	6092
39510	7590	07/01/2005		EXAMINER
HOLLAND & MIDGLEY, LLP P.O. BOX 1840 BOISE, ID 83701-1840				HSIEH, SHIH YUNG
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/716,123
Filing Date: November 17, 2003
Appellant(s): DEVERICH, ROBIN KAY

Matthew L. Whipple
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/23/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft (1,009,671) in view of Rickey (3,554,074).

Regarding claim 7, Kraft discloses a system for instructing a student to play music on a stringed instrument having a fingerboard, the system comprising: sheet music comprising a musical staff and musical notes (Fig. 1) with fingering numbers placed both above and below the musical notes (Fig. 1) for indicating the fret on the neck of the instrument to be engaged (page 1, lines 102-104), and the purpose of indicating to the player the particular strings to be acted on in articulating the respective notes (page 2, lines 18-21).

The difference between Kraft's system and claim 7 is that claim 7 recites colored fingering numbers placed above the musical notes.

Rickey teaches a device having colored fingering numbers (col. 6, line 1; col. 9, lines 53-55; col. 10, lines 15-23) for instructing a student the fingering corresponding to the string. It would have been obvious to one having ordinary skill in the art to modify Kraft's system as taught by Rickey to include colored fingering numbers placed above the musical notes for the purpose of instructing a student the fingering corresponding to the string.

(10) Response to Argument

The Appellant argued that there is no motivation to combine the Kraft and Ricky references, and Kraft and Ricky references are directed to vastly different systems of teaching music. The examiner disagrees for the following reasons:

1. The appellant's claim 7 is directed to "A system for instructing a student to play music on a stringed instrument having a fingerboard". As such, any system in the music art teaching instructing a student to play music on a stringed instrument having a fingerboard applied to the rejection is proper, regardless the appellant's argument that the references are directed to vastly different systems of teaching music. Judging from the drawings, and the teaching means (numbers and colored numbers to indicate finger positons) the references are not vastly different as the appellant argued.
2. Both references are directed to teaching music by numbers (Kraft) and colored numbers (Ricky) of instructing a student to play music on a stringed instrument having a fingerboard.

In response to Appellant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what

they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

In this case, Kraft discloses the claimed invention except colored fingering numbers. Ricky is only relied upon on the teaching of colored fingering number to indicate the finger positions (col. 5, line 75, and col. 6, line 1) regardless of how the numbers are colored. Therefore, the combination of the references as a whole reads on the claim.

In response to Appellant's argument that even if, for the sake of argument only, one of ordinary skill in the art were to combine the teachings of Kraft and Ricky as suggested by the Office, it would not result in the Appellant's invention, as claimed.

The examiner disagrees, because the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. In re Bozek, 163 USPQ 545 (CCPA 1969).

In this case, it would be obvious and easy to one of ordinary skill in the art to replace the black numbers in the Kraft's reference by colored numbers or simply color the numbers for indicating the fingering positions as suggested by Ricky in a music teaching device that providing easier identified colored fingering numbers to indicate the finger positions (col. 5, line 75, and col. 6, line 1) for the purpose of instructing a student to play music on a stringed instrument having a fingerboard.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



SHIH-YUNG HSIEH
PRIMARY EXAMINER

Conferees:

Darren E. Schuberg 

Dave Martin 

Shih-yung Hsieh 